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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/877,130	06/17/97	[illegible]	[illegible]

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EXAMINER	
TEMR [illegible]	

ART UNIT	PAPER NUMBER
[illegible]	

DATE MAILED: 12/08/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/877,150	Applicant(s) Ullrich et al.
	Examiner Sally Teng	Group Art Unit 1646

☐ Responsive to communication(s) filed on _____ .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *one* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-27* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-27* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, and 18-20, drawn to nucleic acid encoding a protein tyrosine phosphatase, classified in class 435, subclass 196.

II. Claims 9-12, drawn to protein tyrosine phosphatase, classified in class 530, subclass 350.

III. Claims 13-17, drawn to an antibody that binds to a protein tyrosine phosphatase, classified in class 530, subclass 388.1.

IV. Claims 21, 26, and 27, drawn to a method of detecting a compound that bind to a protein tyrosine phosphatase, classified in class 435, subclass 7.1.

V. Claims 22, 26, and 27, drawn to a method of identifying a compound capable of activating a protein tyrosine phosphatase, classified in class 435, subclass 7.1.

VI. Claims 23, 26, and 27, drawn to a method of identifying compounds useful for diagnosis of an abnormal condition, classified in class 435, subclass 7.1.

VII. Claims 24, 26, and 27, drawn to a method of diagnosis, classified in class 424, subclass 9.

VIII. Claims 25, 26, and 27, drawn to a method of treatment, classified in class 514, subclass 2.

Claims 26 and 27 are in Groups IV-VIII because these claims encompass each of the methods of Groups IV-VIII.

Although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products appear to constitute patentably distinct inventions for the following reasons:

Inventions I-III are directed to physically and functionally distinct products; therefore, they are patentably distinct inventions and are not required one for the other. The protein can be prepared by materially different processes other than transcription and translation of the encoding polynucleotide, such as chemical synthesis or isolation and purification from its native source. The antibodies can be generated by immunizing animals with synthetic peptides instead of the full length polypeptide and can be used to isolate the protein. Additionally, the antibodies can serve as diagnostic agent in immunoassays and as therapeutic agents. The full length DNA can be used to isolate full length nucleic acid encoding related polypeptides or as a therapeutic agent in gene therapy.

In a similar manner, the above statement regarding "Relationship of Inventions" is applicable to multiple methods.

Inventions IV-VIII are directed to different methods of using the product of Inventions II; thus, they are patentably distinct inventions and are not required one for the other. The methods of Inventions IV-VIII require different starting material and different method steps.

Invention II and Inventions IV-VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process such as to generate antibodies specific for the protein tyrosine phosphatase.

Inventions IV-VIII do not require the products of Inventions I-III.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. Claims 1-27 are generic to a plurality of disclosed patentably distinct species comprising

1) PTP20

2) PCP-2

3) BDP1

4) mCLK2

5) mCLK3

6) mCLK4

7) SIRP

These polypeptides are structurally distinct as shown by their primary sequence. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. A telephone call was made to attorney Charles Berkman on November 23, 1998, to request an oral election to the above restriction requirement, but did not result in an election being made. Attorney specifically requested a written restriction.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention and species to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sally Teng, Ph.D., whose telephone number is (703) 308-4230. The examiner can normally be reached on Mon.-Fri. from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached on (703) 308-2731.

Official papers filed by fax should be directed to (703) 305-3014. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

December 7, 1998

Sally Teng

SALLY TENG
PRIMARY EXAMINER